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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,851	03/25/2004	Shih-Lin Lee	040-307	6672
35870	7590	08/23/2005	EXAMINER	
APEX JURIS, PLLC 13194 EDGEWATER LANE NORTHEAST SEATTLE, WA 98125			SMITH, RICHARD A	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,851

Applicant(s)

LEE, SHIH-LIN

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20050516.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over 6,276,071 to Khachatoorian in view of U.S. 6,182,916 to Lin.

Khachatoorian discloses a tape rule housing structure comprising a housing, provided at its front end with an exit for said tape rule; and with a braking block near its top end, a slip-resistant pad 22 and 24, provided over the periphery of said housing and extending from the upper edge of the front side of said housing toward the upper side and edges of left and right sides and a separate slip-resistant pad at the middle of the lower side extending toward the rear end of the lower side and wherein said slip-resistant pads protrude over each side (column 8, lines 56-59), wherein several recessed portions are further provided regularly at the lower side of said housing such that a slip-resistant protruding portion is formed correspondingly to facilitate gripping thereon, a locating block is further provided by extending from the junction of said lower side and the rear side of said housing in a manner that said locating block can be gripped by the

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finger of a user, said slip-resistant pad is made of a rubber material (column 8, lines 46-66), said slip-resistant pad is formed integrally with said housing through injection molding (column 8, lines 66-67).

Khachatoorian does not disclose said slip-resistant pad extending over the periphery of said housing from the upper edge of the front side of said housing toward and further around the rear side to enclose the tape rule at the middle of the lower side such that the upper and rear sides can be enclosed completely, while only the rear end of the lower side of said housing is enclosed; and wherein said slip-resistant pad is protruded over each side of said housing to achieve a damping effect.

Lin discloses a slip resistant pad protruding over each side of said housing and over the top, back and bottom (figure 2), that a conventional product can be partially or entirely covered with an impact buffer, i.e., a damping effect, and slip resistant layer (column 1, lines 50-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the slip resistant pad, taught by Khachatoorian, to cover the top, back, and bottom rear and to add the impact protection, as taught by Lin, in order to increase the non-slip gripping area and to protect the device from impact should it fall.

With respect to the specific shape as claimed by Applicant: the shape is only considered to be an obvious modification of a slip-resistant pad because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA

1976). In this case, to protect the tape rule housing structure, taught by Khachatoorian as modified by Lin, while not interfering with the brake or with the pencil holding mechanism.

3. Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Khachatoorian and Lin as applied to claims 1-3, 5 and 6 above, and further in view of U.S. 6,216,356 to Li.

Khachatoorian and Lin together teach all that is claimed as discussed in the above rejections of claims 1-3, 5 and 6 except for the slip resistant pad and the housing being provided with different colors.

Li discloses an anti-skid pad 2 made of rubber, the bottom having recessed portions 23, and the body 1, pad 2 and bolt 3, i.e., housing structure, can have different colors so that the products can come in various combinations with different visual effects to stimulate the user's purchase (column 3, lines 56-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the housing, taught by Khachatoorian and Lin, by adding the different colors, as taught by Li, in order to stimulate the user's purchase.

Response to Arguments

4. Applicant's arguments filed May 16, 2005 have been fully considered but they are not persuasive.

With respect to the 071 patent, the examiner agrees that 071 does not show a uniform covering as protection for the tape nor a damping effect.

With respect to the 916 patent and the phrase "is entirely or partially, for example, only at the turning corners, covered with an impact buffer and slip resistant layer...", the examiner disagrees with the Applicant's interpretation that the entirely or partially only describes the application of the material to the turning corners. As written, it appears to the examiner that 916 is providing an example of what components could be "partially" covered, e.g. turning corners. Furthermore, figure 2 shows what appears to be a covering for the entire tape rule and further explains in column 2, lines 43-45 that if partially applied it is preferable to cover the turning corners of the housing which supports the examiner's interpretation.

With respect to it would not have been obvious to combine the two previous patents: Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

With respect to the criticality: Lin discloses different tape measures can be covered either entirely or partially and then describes different locations for application in the specification including application to pushable buttons such as 30. He also addresses its impact buffering ability, its slip resistance and its gripability with respect to its application. Absent any teachings

showing why application to the locations as claimed were not previously possible, then it appears to the examiner that Lin addresses the locations and criticality as claimed.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

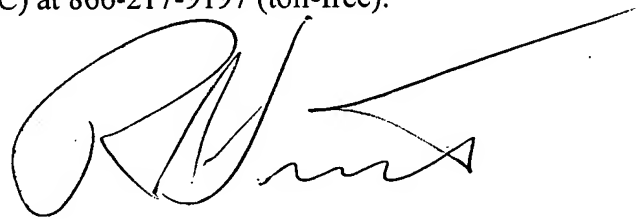
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long horizontal stroke extending to the right.

R. Alexander Smith
Primary Examiner
Technology Center 2800

RAS
August 22, 2005